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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,797

05/22/2007

Yasuhiro Oki

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04/10/2009

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EXAMINER

KLEMANSKI, HELENE G

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

04/10/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,797	Applicant(s) OKI ET AL.	
	Examiner Helene Klemanski	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/28/06 & 10/1/08</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The references cited in the Search Report dated November 9, 2004 have been considered.

Specification

2. The abstract of the disclosure is objected to because it is more than one paragraph in length. Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claims 1, 2, 7 and 8 are objected to because of the following informalities: in claim 1, line 5, the term "[Chem. 1]" should be deleted; also in claim 1, the first line after Formula (I), the left parenthesis should be deleted; lastly in claim 1, the last line, the right parenthesis should be deleted; in claim 2, line 4, the term "[Chem.2]" should be deleted; also in claim 2, the first line after Formula (II), the left parenthesis should be deleted; lastly in claim 2, the last line, the right parenthesis should be deleted; in claim 7, line 3, the left parenthesis should be deleted; lastly in claim 7, the last line, the right parenthesis should be deleted; in claim 8, line 3, the left parenthesis should be deleted and lastly in claim 8, the last line, the right parenthesis should be deleted. Appropriate correction is required.

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Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10 and 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, the phrase "selected from" is considered indefinite since this is improper Markush language. It is the examiner's position that other materials could be present in the Markush group that were not intended by applicants by the use of the phrase "selected from" since this phrase does not exclude other materials. The examiner suggests the language "selected from the group consisting of" in place of this phrase.

In claims 20-22, the terms "used" and "using" are indefinite. A "process" defined in the sole terms of "use of" does not define patentable subject matter under 35 USC 101. See *In re Fong*, 129 U.S.P.Q. 264 (CCPA 1961). The examiner suggests the term "utilizing" in place of the terms "used" and "using" to overcome this rejection. See MPEP 2173.05(q).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 13-22 and 25-31 of copending Application No. 11/597,729 (US 2008/0047461). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

In the above copending Application, it is the examiner's position that it would have been obvious to one having ordinary skill in the art that the pH of the ink composition at 20 °C is from 8.0 to 10.5 since the phthalocyanine dye is the same structure as claimed by applicants and the ink composition is the same composition as claimed by applicants.

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8. Claims 1-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5, 12, 13, 28-32, 34 and 35 of U.S. Patent No. 7,211,132. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are generic to said patent claims and would be obvious thereby.

In the above US Patent, it is the examiner's position that it would have been obvious to one having ordinary skill in the art that the pH of the ink composition at 20 °C is from 8.0 to 10.5 since the phthalocyanine dye is the same structure as claimed by applicants and the ink composition is the same composition as claimed by applicants.

9. Claims 1-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 7-26 of U.S. Patent No. 7,083,669. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

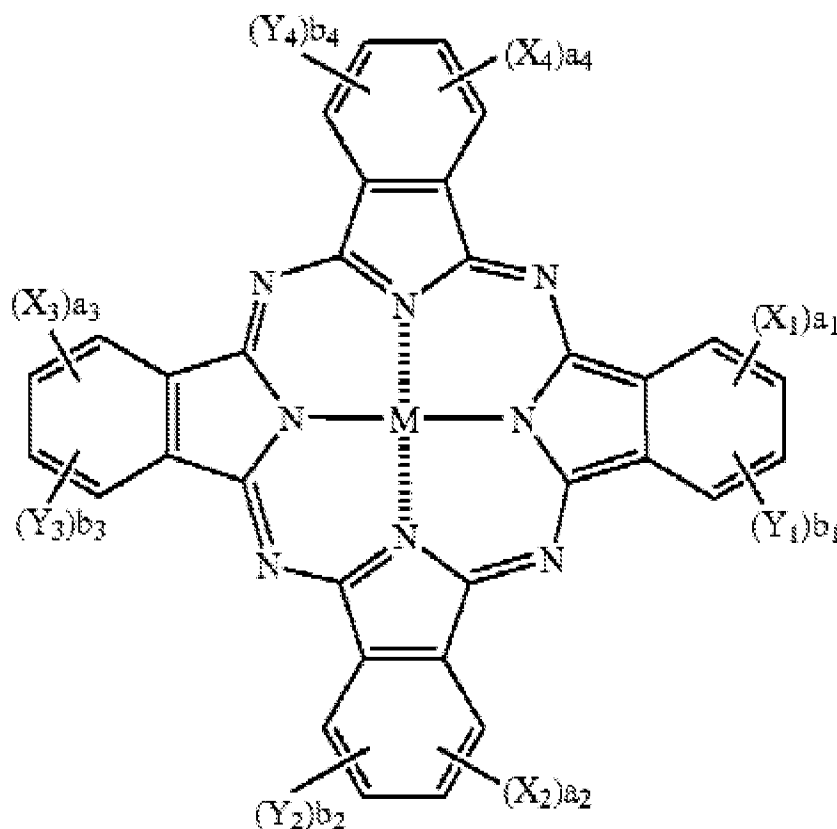
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11. Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Oki et al. (US 7,211,132)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Oki et al. teach a cyan ink composition comprising water, 1-10 wt% of a phthalocyanine dye of the formula (1) and salts thereof

(1)



wherein each of X_1 , X_2 , X_3 and X_4 independently represents $-\text{SO}-\text{Z}$ or SO_2-Z ; each Z independently represents a substituted or unsubstituted alkyl group, a substituted or unsubstituted cycloalkyl group, a substituted or unsubstituted alkenyl group, a substituted or unsubstituted aralkyl group, a substituted or unsubstituted aryl group or a substituted or unsubstituted heterocyclic group; each of Y_1 , Y_2 , Y_3 and Y_4 independently represents H , a halogen atom, an alkyl group, a cycloalkyl group, an alkenyl group, an aralkyl group, an aryl group, a heterocyclic group, a cyano group, a hydroxy group, a nitro group, an amino group, an alkylamino group, an alkoxy group, an amido group, an arylamino group, etc.; a_1 to a_4 and b_1 to b_4 represent the number of substituents of X_1 to

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X_4 and Y_1 to Y_4 ; each of a_1 to a_4 independently represents an integer of 0 to 4, provided that all of them cannot be 0 at the same time; each of b_1 to b_4 independently represents an integer of 0 to 4; M represents H, a metal atom or an oxide, hydroxide or halide thereof; provided that at least one of X_1 , X_2 , X_3 , X_4 , Y_1 , Y_2 , Y_3 and Y_4 is an ionic hydrophilic group or a group having an ionic hydrophilic group as a substituent, 0.1-10 wt% of a naphthalene-based aromatic compound having a carboxyl group at the second position and lithium salts thereof such as a 2-naphthoic acid, 1-hydroxy-2-naphthoic acid, 3-hydroxy-2-naphthoic acid, 6-hydroxy-2-naphthoic acid, 3-methoxy-2-naphthoic acid, 6-methoxy-2-naphthoic acid, 6-ethoxy-2-naphthoic acid and 6-propoxy-2-naphthoic acid, 0.1-5 wt% of a nonionic surfactant such as an acetylene glycol-based surfactant and 3-30 wt% of a glycol ether as a penetrant. The ratio of the amount of the phthalocyanine dye containing in the cyan ink composition to the amount of the naphthalene-based aromatic compound having a carboxyl group at the second position is 1:0.1 to 1:10. The pH of the ink composition is preferably 7.0 to 10.5 at a temperature of 20 °C. Oki et al. further teach a process for printing comprising ejecting the above cyan ink composition onto a substrate. See col. 3, lines 6-64, col. 5, lines 1-5, col. 5, line 56 – col. 6, line 25, col. 9, lines 4-22 and lines 58-63, col. 11, line 18 – col. 12, line 14, col. 13, lines 22-36, col. 16, lines 25-32, col. 41, line 22 – col. 42, line 35, col. 42, line 54 – col. 43, line 67, col. 44, line 53 – col. 45, line 3, col. 45, line 28 – col. 46, line 3, Table A; Cyan dyes 1-3, Table 1; ink composition C-12 and claims 1-3, 5, 12, 13, 28-32, 34 and 35. The cyan ink composition as taught by Oki et al. appears to anticipate the present claims.

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12. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Conclusion

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Helene Klemanski/
Primary Examiner, Art Unit 1793